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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,655	12/05/2003	Michael J. O'Phelan	279.168US2	1280
21186	7590	09/21/2005	EXAMINER	
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402-0938			NGUYEN, HA T	
			ART UNIT	PAPER NUMBER
			2812	

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/728,655	Applicant(s) O'PHELAN ET AL.	
	Examiner Ha T. Nguyen	Art Unit 2812	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 36-46 and 52-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 36-38 and 52-55 is/are allowed.
- 6) ☒ Claim(s) 1-12 and 39-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8-15-5</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Notice to applicant***

1. Applicant's amendment, Response to the Office Action mailed 4-5-05, and Request for a Continued Examination have been entered and made of record. Following is an Office Action responding to the request.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

3. (Claims 1-7, 9-12, and 36-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rorvick et al. (USPN 6009348, hereinafter "Rorvick") in view of Funari (USPN 4171477) or Hancock et al. (GB 825900, hereinafter "Hancock").

Referring to Figs. 4-6 and related text, Rorvick discloses [Re claim 1] a method of joining a connection member to a foil, the method comprising: positioning the connection member and the foil against each other; and forcing the connection member and the foil together between a hardened surface and a staking pin; [Re claim 2] wherein forcing the connection member and the foil together comprises striking the foil with the staking pin and forcing the foil into the connection member; [Re claim 7] wherein the foil comprises an etched anode foil (see col. 5, lines 27-33). But it fails to disclose expressly that the staking pin has a tip of less than or equal to approximately 0.030" (0.762 mm) in diameter. However, the missing limitation is well known in the art because Funari or Hancock discloses a bonding tip of small size (See Funari, col. 8, lines 13-15 and Fig. 3b, Hancock, fig. 4 and lines 16-27). A person of ordinary skill is motivated to modify Rorvick with Funari or Hancock to obtain weld of desired size.

[Re claim 9] The combined teaching of Rorvick and Funari or Hancock discloses a method of joining a connection member to a foil, the method comprising: placing the connection member against a hardened surface; placing the foil between the connection member and a staking tool; and forcing the foil into the connection member with the staking tool, as shown above.

[Re claim 39] The combined teaching of Rorvick and Funari or Hancock discloses a method of joining two or more foils, the method comprising: positioning the two or more foils in

a stack, and forcing the two or more foils together between a hardened surface and a staking pin which has a tip of less than approximately 0.060" (1.524 mm) in diameter; [Re claim 40] wherein the staking pin has a tip of approximately 0.025" (0.635 mm) in diameter; [Re claim 43] wherein forcing the two or more foils together comprises forcing at least one foil comprising an etched anode foil together with one or more other anode foils; [Re claim 44] wherein forcing the two or more foils together comprises forcing three anode foils together, each anode foil comprising an etched foil; [Re claim 45] wherein positioning the foils comprises stacking three etched anode foils in a dimension perpendicular to a major surface of each of the anode foils, as shown above.

[Re claim 46] Rorvick also discloses wherein the two or more foils comprise two or more anode foils, each anode foil approximately 0.004" (0.1016 mm) thick (see col. 20, lines 14-54).

[Re claim 3] Funari also discloses wherein the staking pin has a conical shape approximately 0.015" (0.381 mm) at its tip (See col. 8, lines 13-15 and Fig. 3b). But the combined teaching of Rorvick and Funari fails to disclose expressly the frusto-conical shape. However, this would have been obvious for a person of ordinary skill to do so to obtain small weld with less interference with adjacent welds.

[Re claim 4] Funari discloses the positioning of the staking pin above the hardened surface (see par. bridging cols. 6-7) and Rorvick discloses the tab to be near the edge of the foil (see Fig. 4). But the combined teaching of Rorvick and Funari fails to disclose providing a second staking pin, wherein the two staking pins are approximately 0.040" (1.016 mm) apart; [Re claims 5 and 10] further comprising: positioning the staking pin to a terminal height of approximately 0.001" (0.0254 mm) above the hardened surface; positioning the staking pin to strike at approximately 0.1201" (3.048 mm) from an edge of the foil; [Re claims 6, 11, and 42] wherein forcing the connection member and the foil together comprises forcing the connection member and the foil together at a force between 100 and 1000 pounds; and [Re claim 41] setting the staking pin to a displacement height of approximately 0.001" (0.0254 mm) above the hardened surface. However, it would have been obvious to a person of ordinary skills in the art to have the appropriate number of welds at appropriate location depending in the shape and size of the electrodes and/or connection members and apply an appropriate force to ensure good welding while not breaking the electrodes or connection members.

[Re claim 12] Arguments stated in the rejection of claims 3 and 4 also apply. The combined teaching of Rorvick and Funari or Hancock fails to disclose expressly that the pin is approximately 0.028" (0.712 mm) at its base. However any variation in pin dimension in the present claims is obvious in light of the cited art, because the changes in dimension produce no unexpected function.

The routine varying of parameters to produce expected changes are within the ability of one of ordinary skill in the art. Patentability over the prior art will only occur if the parameter variation produces an unexpected result. In re Aller, Lacey and Hall, 105 U.S.P.Q. 233, 235. In re Reese 129 U.S.P.Q. 402, 406.

4. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rorvick in view of Funari or Hancock, as applied above, and further in view of Strange et al. (USPN 6299752, hereinafter "Strange").

The combined teaching of Rorvick and Funari or Hancock discloses substantially the limitations of claim 8, as shown above.

But it fails to disclose expressly wherein the first anode foil and the second anode foil each comprise an anode foil having a porous structure and a formation voltage of greater than approximately 441 volts.

However, Strange discloses this feature (See col. 10, lines 24-65).

A person of ordinary skill is motivated to modify Rorvick and Funari or Hancock with Strange to obtain a capacitor capable of tolerating high voltage.

Allowable Subject Matter

5. Claims 36-38 and 52-55 are allowed.

Claims 36 and 52 recite "edge-connecting each anode connection member....directly along an exposed end face of each of the connection members".

These features in combination with the other elements of the claims are neither disclosed nor suggested by the prior art of record.

Claims 37-38 and 53-55 variously depend from claim 36 or 52, they are allowed for the same reason.

Response to Amendment

6. Applicants' arguments with regard to the rejections under 35 U.S.C. 103 have been fully considered, but they are not deemed to be persuasive for at least the following reasons.

Applicants argued that Funari does not disclose the use of staking pin and its size. The examiner disagreed. In Funari the pin is for welding, in a broad interpretation, the welding pin functions like a staking pin due to the force applied on the pin to press the components to be joined. The force applied may be small, however in the independent claims there is no limitation concerning the force applied. Besides Funari is used to teach the size of the pin used for connecting a connection member to a foil or connecting two foils together. Even though, Funari does not expressly discuss the size of the pin, however, Funari discloses the sizes of the wire and of the pad on which the wire is applied. Fig. 3b shows that the pin tip is about the size of the wire and as clearly shown in Figs. 3a-3b and 6, the pad 56, which is about 0.002 inches by 0.002 inches, is much larger than the pin tip. Therefore, Funari's tip dimensions must be smaller than 0.002 inches, which is less than the claimed 0.030 inch. Therefore, it would have been obvious to combine Funari with Rorvick to have smaller connection points ensuring good connection why not damaging the foils.

Applicants argued that in the applied references the tab is not placed against a hardened surface. The examiner disagreed. In Rorvick, the layers are welded on a base layer of the apparatus, the base layer is of stainless steel (see paragraph bridging cols. 23-24), which is inherently hardened in the process of manufacturing the metal and the base layer itself. Even with a foil positioned between the tab and the hardened surface the teaching of the applied references still meet the limitations of the claims since the claims do not require the tab to be in physical contact with the hardened surface.

Applicants also argued that Rorvick teaches away from modifying the geometry of the 0.060" weld pin. The examiner disagreed, even though the 0.060" weld pin is "appropriately optimized" for the thickness of Rorvick anode sub-assembly, this does not teach away from having smaller weld for designs where thinner anode sheets or smaller anode design is needed. For a defibrillator, an instrument to be installed in a human body, smaller size is always in great demand. Therefore, there is no teaching way from making smaller design requiring smaller weld, on the contrary, this is a good motivation to combine Funari with Rorvick.

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Therefore, the combined teaching of Rorvick with the applied references does disclose or make obvious all the limitations of the rejected claims.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ha T. Nguyen whose telephone number is (571) 272-1678. The examiner can normally be reached on Monday-Friday from 8:30AM to 6:00PM, except the first Friday of each bi-week. The telephone number for Wednesday is (703) 560-0528.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael S. Lebentritt, can be reached on (571) 272-1873. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ha Nguyen
Primary Examiner
9- 16- 05